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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/933,176 | 08/21/2001 | Alain A. Meilland | 006450-367 | 6434 |

7590 05/06/2003
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
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Alexandria, VA 22313-1404

EXAMINER

LOCKER, HOWARD J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1661

DATE MAILED: 05/06/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.



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| APPLICATION NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|--------------------|-------------|-----------------------|---------------------|

EXAMINER

ART UNIT

PAPER NUMBER

7

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on February 28, 2003

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ ~~Claims~~ The claim is ~~is~~ pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ ~~Claims~~ The claim is ~~is~~ rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 6

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

09/933176
PTOL-328 (Rev. 10/95)

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."

The claim is rejected under 35 U.S.C. 102(b) as being anticipated by **FR PBR 0171379** (filed on May 11, 1998 and published on May 10, 1998); or resulting **Grant/Reg. Number 11589** (dated January 10, 2000 and published on February 10, 2000); or **QZ PBR 990285** (filed on February 25, 1999 and published on July 15, 1999); or resulting **Grant/Reg. Number 6301** (dated June 5, 2000 and published on August 15, 2000), taken in view of the admission that "*Plants of the 'Meichibon' variety are understood to have been first made available to the public for non-experimental purposes in France on approximately May 20, 1999*" and the MEILLAND RICHARDIER catalog excerpt (January 2000) submitted by applicant as Exhibit D in the papers filed March 06, 2003, which per applicant's admission "*was made available to others in France and identifies the 'Meichibon' variety*".

Each of the published foreign documents set forth above constitute a printed publication under 35 U.S.C. 102 because it is accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226; 210 USPQ 790, 794 (CCPA 1981). The plant breeder's right grants are entered in the Register of Plant Novelties, and a notice is published when a variety is entered in the Register. In the European Community, every two months the Community Plant Variety Office published an Official Gazette containing all the information appearing in its Registers. Other information the CPVO feels important to the public may also be published in the Gazette.

Thus, information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art more than one year prior to the date of filing in the United States. A publication relied upon as prior art under 35 U.S.C. 102(b) must be enabling. The text of the relied upon publications standing alone would not enable one skilled in the art to practice the claimed invention. However, when the claimed subject matter is disclosed identically by a reference, an additional reference may be relied upon to show that the primary reference has an "enabled disclosure" (*In re Samour*, 571 F.2d 559, 197 USPQ 1 (CCPA 1978) and *In re Donohue*, 766 F.2d 531, 226 USPQ 619 (Fed. Cir. 1985)). See also MPEP Section 2131.01. When the claim is drawn to a plant, the reference, combined with the knowledge in the prior art, must enable one of ordinary skill in the art to reproduce the plant (*In re LeGrice*, 201 F.2d 929, 133 USPQ 365 (CCPA 1962)). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure (*Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Board of Patent Appeals and Interferences, 1992)) ("The issue is not whether the [claimed] cultivar Siokora was on public use or sale in the United States but, rather, whether Siokora seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokora cultivar disclosed in the cited publications."). See also MPEP section 2121.03.

Applicant admits at page 5 of the March 6, 2003 response that plants of the 'Meichibon' variety were made available to the public outside of the United States more than one year prior to the filing date of the instant application. This constitutes evidence that the claimed cultivar was available to the public more than one year before the present application's U.S. filing date.

The above referenced foreign publications are thus enabled because the disclosed cultivar could have been propagated from publicly available materials, and one skilled in the art would have the knowledge of how to do so, given the notoriety of various methods of asexual propagation. See, e.g., *Thomson, supra*. See also Cooper, *Biotechnology and the Law*, Section 8.05 (1998 Clark Boardman Callaghan). "In essence then, a plant patent applicant cannot lose his rights through public description of the new variety so long as he does not make the stock available for propagation by the public."

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the printed publication, combined with knowledge in the prior art, would have enabled one of ordinary skill in the art to reproduce the claimed plant, and said printed publication was published more than one year prior to the date of application in the United States (*In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could have reproduced the plant from a publicly available source, then the publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ 2d, 1618, 1620, (Bd. Pat. App. & Inter. 1992).

Information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art. A publication relied upon as prior art under 35 U.S.C. 102(b) must be enabling. The text of the relied upon publication standing alone would not have enabled one skilled in the art to practice the claimed invention. When a claim is drawn to a plant, the reference, combined with knowledge in the prior art, must enable one of ordinary skill in the art to reproduce the plant. That plants of the instant cultivar were admittedly made available more than one year prior to the filing date of the instant application enables the referenced documents because the disclosed cultivar could have been propagated from publicly available materials, and one skilled in the art would have the knowledge of how to do so, given the notoriety of various methods of asexual propagation. See, e.g. *Thomson*,

supra. See also Cooper, Biotechnology and the Law, section 8.05 (1998 Clark Boardman Callaghan). "In essence then, a plant patent applicant cannot lose his rights through public description of the new variety so long as he does not make the stock available for propagation by the public".

RESPONSE TO APPLICANT'S ARGUMENTS

The contention that foreign commercial or public use is not a bar to patentability under 35 U.S.C. 102(b) is noted but is not relevant. The clear wording of 35 U.S.C. 102(b) is "A person shall be entitled to a patent unless - ... (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or sale in this country, more than one year prior to the date of the application for patent in the United States..." There is no restriction of the bar under 35 U.S.C. 102(b) to printed publications in this country. That is, the statute explicitly extends the scope of the bar from printed publications to this or a foreign country. There is no requirement that a printed publication that describes the invention be printed or enabled in this country. The second clause of 35 U.S.C. 102(b) barring public sale or use in this country is not relevant because a rejection under 35 U.S.C. 102(b) over the foreign published documents, as enabled by the admitted availability of the plants outside the U.S. more than one year prior to the date of domestic filing, is not over public use or sale, but on a printed publication.

The argument that the claimed plant was not available in the United States more than one year prior to domestic filing is not persuasive, as applicant is attempting to create a geographic component of enablement, which does not exist in statute or in case law. For a patent specification to be enabling, there is no requirement that the starting material required to produce the claimed invention must be located in the United States. See, for example, *Ex Parte Rinehart* (10 USPQ2d 1710), where a specification was

found to be enabling even though the required biological material was only available in the ocean off the coast of Central and South America. Even if there were a requirement that the plant be available in the United States, applicant has not explained why the skilled rose grower could not have purchased the claimed plant and arranged for its importation into the United States through the usual channels (customs and USDA quarantine).

Arguments that any information contained in the Exhibits would not enable a person skilled in the art to reproduce and thereby be in possession of the claimed plant with just a written description is not persuasive, because a more detailed description of the claimed cultivar would not confer novelty. See MPEP 2112.

Applicant then argues that the plant in *In re LeGrice* was available only in a foreign country and that the fact situation there is the same as in the instant application. This argument is not persuasive because in *LeGrice*, applicant never admitted that the rose cultivar was on sale anywhere. Instead applicant stated, "Prior public use or sale are the avenues by which a plant enters the public domain" (*LeGrice*, page 372). The court then added "section 102(b) requires that an inventor, who has placed his invention in the public domain, file his application within one year thereafter" (page 372).

Applicant's contention that the Court knew that the claimed plant had been on sale and found that fact irrelevant is contrary to the written opinion cited above. The *LeGrice* decision repeatedly returns to the question of whether the invention was "in the possession of the public". Clearly, if an invention is on sale to the public, then the public must have possession of it. As stated by the Board of Appeals and Interferences in *Ex Parte Thomson*, "the court's holding was based on the specific 'printed publications' before it, and no indication was given that the 'prior catalogue publication' before it evidenced commercial availability in a readily enabling form" (p. 1622).

Applicant then argues that the examiner should not rely upon *Ex Parte Thomson* because that case involved an application for a utility patent and as such is unsound from both technical and legal standpoints. These arguments are not persuasive because the question in *Thomson*, as in *LeGrice*, was "what is required to "enable" a printed publication describing a plant? Except for the type of patent sought, the instant application presents the same fact pattern as in the *Thomson* case. Moreover, applicant has misconstrued the *Thomson* decision. The printed publications cited in *Thomson* were not enabled by applicant's deposit of seeds, but by the commercial availability of the seeds outside the U.S. As stated in *Thomson* "we are convinced that the skilled cotton grower would have had the wherewithal, upon reading the publicly disseminated reference articles, to purchase the commercial available Siokora seeds, and employ conventional techniques to plant and nurture the seeds to maturity in order to obtain the claimed invention, i.e., Siokora plants, seeds and pollen. It is reasonable to conclude that, at the time the cited articles were published, skilled artisans throughout the world would have found Siokora seeds readily available on the open market."

Applicant argues that the published information relative to the cultivar 'Meichibon' could not have enabled one skilled in the art to reproduce the plant. This argument is not persuasive because no amount of description would be an enabling disclosure. Public notice of a Plant Breeder's Right application informs the public of the existence of the plant. Sale or other public use of said plant then puts it in the public's possession. If a plant is in the public's possession, then a printed publication can be a statutory bar. The following is a passage from *LeGrice*, page 379:

The mere description of the plant is not necessarily an "enabling" disclosure. Such descriptions, just as in the case of other types of inventions, in order to bar the issuance of a patent, must be capable, when taken in conjunction with the knowledge of those skilled in the art to which they pertain, of placing the invention in the possession of those so skilled.

The sale or use of the plant in the public domain and the knowledge in a printed application would enable a person skilled in the art to reproduce the plant, thus the publication is a statutory bar under 35 U.S.C. 102(b).

Arguments brought forth relative to substantive departure from prior practice within the art have been considered but are not persuasive. The only change in policy is in the use of rule 1.105, which was published in the Federal Register in the PBG advance notice, notice of proposed rulemaking and final rule. While applicant refers to the 102(b) rejection as the policy change, the substantive policy is the implementation of the existing 35 U.S.C. 102(b) to a given factual pattern, hardly a substantive policy change. The factual pattern is analogous to the opinion in *Ex Parte Thomson*, which demonstrates the strength of 35 U.S.C. 102(b) under such circumstances. The USPTO cannot ignore 35 U.S.C. 102(b) just because of the recognition of a recurring factual pattern that runs counter to that paragraph where it may not have been recognized before.

2. The information provided by applicant relative to the requirement for information under 37 CFR 1.105 as set forth in the Office action mailed November 1, 2002 is sufficient.

3. Effective May 1, 2003, the USPTO has a new Commissioner for Patents address. Correspondence in patent related matters to organizations reporting to the Commissioner for Patent must now be addressed to:

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450.

For further information regarding the new address, see *Correspondence with the United States Patent and Trademark Office*, 68 Fed. Reg. 14332 (March 25, 2003).

4. Applicant is advised of the new optional procedures for amending the specification and claim under 37 CFR 1.121. The new procedures are optional until July, 2003, and such may become mandatory at that time. Applicant may review same on the internet at the following site:
<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>

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Art Unit 1661

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5. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 703-308-2924, and whose normal work hours are Monday through Thursday, from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Bruce Campell, can be reached at 703-308-4205.


Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

TELECOPY/FACSIMILE TRANSMISSION

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to this Group via the PTO Fax Center in Crystal Mall 1 (CM 1). The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM 1 Fax Center number is 703-308-4556 or 703-305-3592.

Howard J. Locker/hjl

April 21, 2003


HOWARD J. LOCKER
EXAMINER
GROUP ART UNIT 1661